



PATENT
20020/10012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

FISCHBACH et al.

Serial No.: 10/728,403

For: METHOD AND
APPARATUS TO LOCK A DUST
COVER IN A FIREARM
HOUSING

Filed: December 5, 2003

Group Art Unit: 3641

Examiner: Johnson

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June 8, 2006


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**PETITION FOR WITHDRAWAL OF RESTRICTION
REQUIREMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

In response to the restriction requirement made final in the Office action dated December 8, 2005, the applicants hereby petition the commissioner for reconsideration and reversal of the restriction requirement. Applicants traversed and requested reconsideration of the improper election requirement in their response mailed September 30, 2005. Therefore, the right to file this petition has been properly preserved.

I. The Restriction Requirement Misconstrues the Claims

By way of background, the claims of the instant application are directed toward methods and apparatus to lock a dust cover of a firearm housing. From the day this application was filed, *all of the claims* were either directed toward *a firearm having a dust cover with a magnetic lock* (see

original claims 1-21), a method of operating **a firearm including a dust cover with a magnetic lock** (see claim 22), or a method of manufacturing **a firearm having a dust cover with a magnetic lock** (see claim 23).

The Office issued a first Office action on December 2, 2004. That Office action examined all of the claims together and rejected those claims over Murello, U.S. Patent 6,523,293 entitled "Arrangement For Opening The Dust Flap of a Firearm," Swink, U.S. Patent 4,752,495 entitled "Merchandising Stand," and Su, U.S. Patent 6,550,298 entitled "Lockset Keyway Cover-Up Mechanism." Since Murello, the primary reference relied upon in the first Office action, was directed to a firearm having a dust flap, it is clear that, from the start of this examination, the Office has known full well that the claims of this application are limited to firearms with a dust flap and a magnetic lock.

This understanding is further supported by the applicants' filings in this case. In addition to the specification and drawings filed herewith – all of which plainly describe firearms with a dust flap and a magnetic lock – the applicants filed a response on June 2, 2005 overcoming the rejections¹ made in the first Office action by explaining that Swink was not analogous art to the claimed firearm related inventions. For instance, applicants explained:

For example, **independent claim 1 recites a firearm including a dust cover and a magnetic lock** to secure the dust cover in the closed position. The Office action states that Murello contains all the elements of claims 1 except a magnetic lock, but that it would be obvious to add such a lock to Murello in view of

¹ That the rejections from the December 2, 2004 Office action were overcome is demonstrated by the fact that the most recent Office action abandons all of those rejections.

Swink, which employs a magnetic lock to secure a door of a cabinet in the closed position. This position is in error for numerous reasons.

First, ***the Swink reference is not analogous art to the inventions recited in claim 1.*** “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992). ***Here, no reasonable inventor concerned with securing a dust cover to a firearm in a manner that would allow for the dust cover to open and close would ever have thought to look to the merchandise display cabinetry industry for a potential solution to the problem. A person of ordinary skill in the firearm art simply does not look to the furniture/cabinetry arts for teachings on how to construct a firearm.*** As such, an inventor faced with the problem of securing a dust cover to a firearm such that it can be opened upon, for example, the firing of a cartridge, would never have examined how the retail industry displays merchandise in cabinets that have doors as part of the search for a solution to his problem. Indeed, one would only look to Swink after learning of the idea of using a magnetic lock for the dust cover of a firearm from the instant application. Without the teaching of the applicants’ own specification, one would never consider Swink in trying to create a latch for the dust cover of a firearm. In short, the Swink reference is non-analogous art. The rejections based on Swink are, therefore, in error and must be withdrawn.

(Response to Office action Dated December 2, 2004)(emphasis added). Thus, it is abundantly clear from the file history prior to the restriction requirement that both the Office and the applicants understood all of claims 1-23 to recite firearms including a dust cover and a magnetic lock.

Subsequently, the prosecution history of this case took a surprising course of events. Specifically, a new Examiner took over the case after the

above-noted response. Rather than seeking to continue to address the patentability issues presented in this case, the Examiner has artfully issued a restriction requirement that subtly, but significantly, re-construes pending claims 1-21 to no longer be directed to firearms.

Specifically, the Office issued a restriction requirement on August 31, 2005. That restriction requirement required the applicants to choose between claims 1-21 and claims 22-23. According to the restriction requirement, claims 1-21 were “drawn to a dust cover in combination with a magnetic lock” whereas claims 22-23 were drawn to “a method of operating or manufacturing a firearm with a breech block in combination with a dust cover.” According to the Office action, “the combination as claimed does not require the particulars of the subcombination.”

Applicants traversed the restriction requirement on September 30, 2005. In that submission, the applicants amended the dependencies of claims 22 and 23 to refer to claim 1 such that it was clear that claim 22 specifically recited “a method of operating a firearm as defined in claim 1” and claim 23 specifically recited “a method for manufacturing a firearm as defined in claim 1.” As a result, it was abundantly clear that the Office action’s prior statement that “the combination as claimed does not require the particulars of the subcombination” was inapplicable to claims 1-23 and that the basis for the restriction requirement had been eliminated.

In response, the Examiner issued a new Office action on December 8, 2005 withdrawing all of the prior art rejections in favor of new rejections ***based on art not related to firearms***, and making the restriction requirement final. In that new Office action, it became clear that the Examiner is basing

his restriction requirement on an unfair and overly broad construction of claims 1-21. In particular, despite the fact that claims 1-21 are quite literally directed to “a firearm,” and claims 22-23 are directed toward operating/manufacturing the firearm of claim 1, the Examiner’s rationale for sustaining the Office action states “since the second grouping contains features directed to a cover in combination with a firearm containing a breech block, this is considered to be a patentable distinction from a dust cover *independent of* a firearm containing a breech block.” (emphasis added). Thus, despite the fact that the prior Examiner and the applicants had agreed that all of claims 1-23 were directed toward firearms having a dust flap and a magnetic lock, the new Examiner completely changed the construction of claims 1-21 by arguing that claims 1-21 are not limited to firearms in an effort to justify restriction.

Since the history of this case already demonstrates that the Office and applicants had agreed that claims 1-21, like claims 22-23 are directed toward firearms with a dust flap and a magnetic lock, it is inappropriate for the Examiner to now switch to an overbroad construction in an effort to enforce a restriction requirement. Accordingly, the Director should reverse the restriction requirement as being based on an incorrect construction of the claims.

II. The Restriction Requirement Improperly Changes the Classification of Claim 19

Notably, although the Office action of December 8, 2005 makes the restriction requirement final, it changed that restriction requirement without giving the applicants an opportunity to respond. Specifically, dependent claim 19 was originally grouped in Group 1 (i.e., claims 1-21). Claim 19

specifically recites “A firearm as defined in claim 1 wherein the dust cover is pivoted from the closed position to the open position in response to a recoil movement of a breechblock.” Without prior notice to applicants, the Examiner is now trying to buttress his incorrect claim construction (which ignores the history of this case, the applicants’ specification and drawings, and the express recital of “firearm” in the claims), by now grouping apparatus claim 19, which recites internal structures of a firearm, with method claims 22 and 23. (See Office action Dated December 8, 2005). It is unfair and inappropriate to change the classification of claim 19 without giving the applicants an opportunity to respond. For instance, changing the classification of claim 19 changes the scope of the restriction requirement in a manner that applicants would not have guessed, namely, by now ***grouping a dependent apparatus claim in the class that previously included only method claims***. On this basis also, the restriction requirement should be overturned.

III. The Restriction Requirement Was Prejudicially Unfair

As noted above, the restriction requirement provided the applicant’s with only two choices, namely, choose Group I (i.e., apparatus claims 1-21) or Group II (i.e., method claims 22-23). However, because the Examiner had, unbeknownst to applicants, changed the construction of claims 1-21 from firearms with a dust flap and a magnetic lock to dust flaps in general, the restriction requirement actually presented the applicants with the choices of: (1) pursuing a class that was far broader than anything applicant every intended to claim or (2) pursuing the two pending method claims. In effect,

the applicants were not offered the opportunity to continue to pursue their apparatus claims to firearms.

Given the fact that all prior communications from and to the USPTO had indicated that the apparatus claims were directed to firearms, presenting the restriction requirement in this unclear manner effectively eliminated the applicants ability to continue to pursue the apparatus claims that they understood to be pending in the case. Clearly, preventing applicants from pursuing claims to their invention is not the intent of restriction practice. Accordingly, the manner in which this restriction requirement was presented was unfair to the applicants, and inconsistent with the goal of efficient patent prosecution before the USPTO. Accordingly, in the interest of fairness, the restriction requirement must be reversed.

IV. Possible Consequence of Restriction Requirement

As it stands, the Examiner may attempt to use the restriction requirement to preclude the applicants from pursuing apparatus claims to their invention, despite the fact that they elected the apparatus claims. More specifically, none of the art applied in the Office action of December 8, 2005 relates to a firearm. On the contrary, the applied art is directed to a cosmetic case (Kamen, U.S. Patent 5,135,012), an attaché case (O'Reilly, U.S. Patent 3,807,537), a pet door (Needham, U.S. Patent 4,480,407), and a refrigeration device (Anderson, U.S. Patent 2,659,114, Meyer et al., U.S. Patent 5,950,450, Reichert et al., U.S. Patent 4,448,464, Reed, U.S. Patent 4,326,383, and Mark, U.S. Patent RE23,920). The Examiner is applying this art by improperly

ignoring the fact that each apparatus claim is literally directed toward a “firearm.”

Although applicants believe any such amendment is unnecessary, one way to eliminate any alleged ambiguity² about the scope of those claims is to amend the term housing to “firearm housing” or equivalently “receiver.” However, the inappropriate restriction requirement could be used to improperly argue that such an amendment would move the claims out of the scope of Group 1 (the elected “dust flap” classification). Accordingly, reversal of the restriction requirement is required to ensure that the applicants are not precluded from pursuing claims to their invention by the Examiner’s unannounced shift in claim scope embedded within the restriction requirement.

In other words, it now appears that the Examiner has stealthily laid a trap for the applicants. By ignoring the prior discussions in the case and adopting an excessively overbroad construction of the claims, the Examiner presented the applicants with an unfair choice. In the restriction requirement of August 31, 2005, the Examiner only offered the applicants a choice of claims 1-21, which he now contends is unrelated to firearms, and claims 22-23, which as noted above, relate to the operation and manufacture of a firearm. Therefore, in choosing the first inventive group, the Examiner is now contending that the applicants elected a group that is independent of firearms. The Examiner’s position is based, of course, on an unfair switch from the correct claim construction utilized in the first action, namely, that claims 1-21

² As noted above, any such ambiguity could only arise by ignoring the literal claim language, the specification and drawings of the application, and the prior correspondence between the USPTO and the applicant in this case.

are, as they state, directed to a “firearm,” to a new, previously unannounced claim construction that ignore the term “firearm” in claims 1-21.

Accordingly, applicants have filed this petition to request the Director to intervene to reverse the restriction requirement and declare that all pending claims 1-23 be examined together as all being directed to a firearm with a dust flap and/or a method of operating or manufacturing such a firearm.

V. There Is No Serious Burden In Examining Claims 1-23 Together

Finally, applicants reiterate their position that there is no serious burden on the Examiner of examining dependent claims 22 and 23 with apparatus claims 1-21. Examining the patentability of the method of manufacturing the firearm of claim 1 as recited in claim 23 cannot require serious additional effort. Similarly, examining the patentability of the method of operating the firearm of claim 1 recited in claim 22 provides no serious burden on the Examiner. On the contrary, the only serious burden faced in this case, lies on the applicants for having to address the hidden traps presented by the restriction requirement issued in this case.

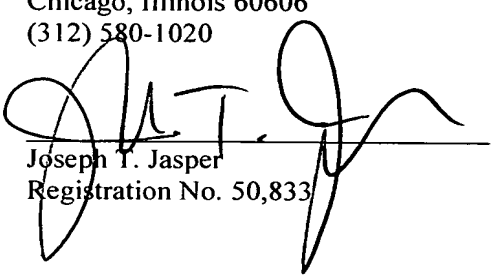
In conclusion, restriction requirements are an appropriate tool to maintain the focus of examination on one related inventive concept in a given patent application. Presenting restriction requirements midway through a prosecution history in a confusing manner that unfairly characterizes the invention in an overbroad manner in an effort to intentionally change the express intent of applicants’ claims is not an appropriate use of restriction practice. Accordingly, the Director’s supervisory authority is required to overturn the restriction requirement and prevent an injustice.

A check in the amount of \$130 is enclosed to cover the fee for this petition. The Office is hereby authorized to charge deposit account number 50-2455 for any additional fees due in connection with this petition.

Respectfully submitted,

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By:



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